



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,671	04/16/2004	Michael Chen	03224.0006U2	9595
23859 7590 07/10/2008 Ballard Spahr Andrews & Ingersoll, LLP SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915				
EXAMINER PARRA, OMAR S				
ART UNIT		PAPER NUMBER		
2623				
MAIL DATE		DELIVERY MODE		
07/10/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,671

Applicant(s)

CHEN ET AL.

Examiner

OMAR PARRA

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-11, 13, 16, 18-25, 27-32, 37, 38 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11, 13, 16, 18-25, 27-32, 37, 38 and 40-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 04/16/2008 have been fully considered but they are not persuasive.

In response to applicant's arguments:

Claims 1, 4, 27 and 28 (pages 10, 11, 13)

Applicant argues that Holtz does not disclose *creating a targeted integrated image by combining two images "to form a targeted integrated image for delivery to the user."* Thus, *the images are combined before being delivered to the user* (Remarks, page 10 second to last paragraph). To this matter, the examiner respectfully disagrees.

Holtz teaches combining two images to form a targeted integrated image for delivery to the user. As can be seen on the example given, the enhancement media server 115 assembles a plurality of segments of a user requested topic with advertisement segments between them. Once they are put together, the customized group of segments and advertisements are sent down to the user for presentation. The combination of the images is performed before delivery to the user (col. 16 line 49-col. 17 line 5). Therefore, the customized group of segments plus the additional advertisement are assembled together on the server prior delivery to the user, and not on the user receiver as seemed to be implied by the applicant. Additionally, the applicant seems to be confusing the advertisements presented to the user prior the reception of the customized group of segments (col. 16 lines 34-48) with the

advertisement inserted in the targeted integrated video content (advertisement segments inserted between the content segments, col. 16 lines 49-65). The former advertisement is presented to the user while the server is selecting content and the targeted additional advertisement.

Applicant argues that Holtz does not disclose *combining the second image comprising a barker advertising content of potential interest to the user with the first image or the third image to form a targeted integrated image for delivery to the user* (page 10 last paragraph-page 11, first paragraph). To this matter the examiner, respectfully disagrees.

As defined on applicant's specifications (page 1 lines 9-17), barkers are no more than short video clips about video content or products. In the same manner, Holtz teaches that the advertising being inserted and presented to the user can be one of a diverse type, among which, video clips are present (col. 9 lines 45-54; col. 18 lines 12-22; col. 34 lines 20-61). The advertisement integrated in the group of segments is based on or in response to actual demands and behavioral patterns of the online users (col. 18 lines 35-59); where the advertisement is inserted to be presented to targeted users that are most likely to purchase a promoted item, based on the behavioral pattern of the online users (col. 18 lines 56-62).

Additionally, the applicant argues that Holtz does not disclose *determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user while the user is receiving a first image comprising a trick file comprising a subset of frames from a video file for viewing via*

digital cable television (page 11 second paragraph). To this matter, the examiner respectfully disagrees.

As explained in the previous Office Action, Holtz teaches that the integrated video segments (live or previously aired, col. 41 line 63-col. 42 line 2) can be 'trick-played' (fast forwarded, paused, rewind, stopped, etc; col. 42 lines 10-34). Also, that the advertisement and the actual content are determined based on user preferences comprising content habits (col. 13 lines 3-31; col. 18 lines 35-lines 62; col. 32 lines 32-54; col. 37 lines 43-63). Additionally, the advertisement presented to the user can be watched on other portions of the screen (1114 a, b, 1116, 1112, Figs. 11-13; col. 38 lines 35-62), while the video content is being played (or trick-played, col. 42 lines 10-34). Therefore, given that Holtz' invention determines content and advertisement based on user preferences and sends them in an integrated package advertisement and that content (which can be trick-played) to be displayed in different screen portions, another advertisement would be determined to fill the advertisement section even if the actual content is trick-played. In addition, Holtz also teaches that when the content is being indexed, pause commands are inserted in the integrated media (col. 22 line 46-col. 23 line 10).

Claim 25:

Applicant argues that Holtz does not *show wherein the first image comprises a menu or programming guide* (page 12). To this matter, the examiner respectfully disagrees.

Holtz teaches sending a menu or listing 1104 to be displayed to the user (col. 8 line 24-col. 9 line 20; col. 17 lines 25-51) and, also that a specification menu is also sent to the user to customize the desired content (col. 16 lines 15-33; col. 17 lines 1-5; col. 31 lines 27-56). Based on explicit or indirect user parameters specifications, the media server determines the content and advertisement for the user (col. 12 line 62 -col. 13 line 31; col. 18 lines 35-lines 62; col. 32 lines 32-54; col. 37 lines 43-63).

Applicant also argues that *wherein the combiner inserts the second image within the first image or the third image, wherein the first image or the third image is adapted to appear to the user to be paused* (page 13).

Holtz teaches that the advertisement are inserted between the first image and/or the third image. Holtz also teaches that an image can be added in a PIP setting, while still being able to controlled or trick-played (col. 41 line 56-col. 42 lines 39). The content and the advertisement can be watched in separate screen portions while the video is paused, as discussed above.

Claims 4, 27 and 28

The arguments about the profiles based on history of selections of these claims were addressed above for both claims 1 and 25.

Claims 5-29

The applicant argues that does not disclose *expressly or inherently, determining content of potential interest based on a user preference* (page 15). To this matter, the examiner respectfully disagrees.

Holtz teaches that content is determined based on a direct request from the user or on a profile that's created based on information captured about user selections when the user logs on to the system (col. 13 lines 3-39; col. 17 lines 25-51; col. 18 lines 35-62). Therefore, it is inherent that the identity of the user is determined through the log in for selecting content that fits that specific user.

Claims 9-11, 13, 16, 37-38 and 40

Claims 9-11 and 40: Applicant argues that Holtz does not *show wherein the first image comprises a menu or programming guide* (page 12). To this matter, the examiner respectfully disagrees.

Holtz teaches sending a menu or listing 1104 to be displayed to the user (col. 8 line 24-col. 9 line 20; col. 17 lines 25-51) and, also that a specification menu is also sent to the user to customize the desired content (col. 16 lines 15-33; col. 17 lines 1-5; col. 31 lines 27-56). Based on explicit or indirect user parameters specifications, the media server determines the content and advertisement for the user (col. 12 line 62 -col. 13 line 31; col. 18 lines 35-lines 62; col. 32 lines 32-54; col. 37 lines 43-63).

Claims 13 and 37: Applicant argues that Holtz does not disclose *wherein the processor begins determining content of potential interest to the user responsive to the user requesting video content* (page 16). To this matter, the examiner respectfully disagrees.

Holtz teaches that content is determined based on a direct request from the user or on a profile that's created based on information captured about user selections when the user logs on to the system (col. 13 lines 3-39; col. 17 lines 25-51; col. 18 lines 35-62).

Claim 38: Applicant argues that Holtz does not disclose *wherein the processor begins the determining content of potential interest to the user as the user receives the video content* (page 16).

Holtz teaches that the selection of content of potential interest to the user begins while the user receives advertisement (col. 16 lines 34-48).

Claims 18-20 and 41-43

Applicant argues that Holtz does not disclose *repeating the steps for creating at least one new targeted integrated image for delivery to the user* (page 17). To this matter, the examiner respectfully disagrees.

Holtz teaches creating integrated targeted content for a user based on a expressly user-defined parameters/profile or based on a profile that's created with information captured about user selections when the user logs on to the system. Given that the user changes, for at least that reason, the future content selected has to be new content on a system that is inherently not designed for being used for just one time. However, Holtz also explicitly teach that he steps of selecting targeted are repeated since every single time the user logs on the system, new targeted content is available

for the user, which he/she has to select or reject. The user can also request specific content (col. 13 lines 3-39; col. 17 lines 25-51; col. 18 lines 35-62).

Claim 21:

Applicant argues that Holtz does not disclose *further comprising at least one of the first image, the second image, and the third image prior to performing the targeted integrated image* (page 18). To this matter, the examiner respectfully disagrees.

Holtz teaches that the content that's going to be utilized for selection is compressed from any format to MPEG along with metadata information for quick retrieval (col. 25 line 34-col. 26 line 16).

Claims 22-24 (page 18):

Arguments for these claims were responded above in the response of claim 25.

Claims 6-8 and 30-32 (page 19):

Applicant states that the cited language does not disclose the methods and apparatuses of these listed claims. To this matter, the examiner respectfully responds that the cited language discloses the methods and apparatuses for these claims as explained in the previously presented Office Action.

Therefore, the examiner respectfully believes that the art of record still covers applicant's invention as claimed and maintains the rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **1, 4-5, 9-11, 13, 16, 18-25, 27-29, 37, 38 and 40-43** are rejected under 35 U.S.C. 102(e) as being anticipated by Holtz et al. (hereinafter 'Holtz', Patent No. 6,760, 916).

Regarding claims 1, 13 and 22-25, Holtz teaches an apparatus (with respective method) for creating at least one targeted integrated image for delivery to a user, the apparatus comprising:

a processor (**Streaming server 125 in Fig. 1, upon Enhanced media server 115 request, searches for content on the fly that a user requested - col. 9 lines 21-36 and Advertisement server 135 provides advertisement to be put together with elected content - col. 9 lines 45-54; col. 16 lines 34-63**) for determining as the user receives or requests a trick file comprising a subset of frames from a video file content of potential interest to the user based on at least one user preference prior to or during the user's request for a first image (**Integrated video segments -live or**

previously aired, col. 41 line 63-col. 42 line 2- can be 'trick-played' -fast forwarded, paused, rewind, stopped, etc; col. 42 lines 10-34. The advertisement and the actual content are determined based on user preferences comprising content habits (col. 13 lines 3-31; col. 18 lines 35-lines 62; col. 32 lines 32-54; col. 37 lines 43-63). Additionally, the advertisement presented to the user can be watched on other portions of the screen (1114 a, b, 1116, 1112, Figs. 11-13; col. 38 lines 35-62), while the video content is being played (or trick-played, col. 42 lines 10-34). Therefore, given that Holtz' invention determines content and advertisement based on user preferences and sends them in an integrated package advertisement and that content (which can be trick-played) to be displayed in different screen portions, another advertisement would be determined to fill the advertisement section even if the actual content is trick-played. In addition, Holtz also teaches that when the content is being indexed, pause commands are inserted in the integrated media -col. 22 line 46-col. 23 line 10, suggesting that while content or ads are being searched to put them together, content is already paused).

comprising a menu or a programming guide or while the user is receiving the first image (menu 1104 is sent to the user to be displayed, col. 8 line 24-col. 9 line 20; col. 17 lines 25-51 and, also a specification menu is also sent to the user to customize the desired content, col. 16 lines 15-33; col. 17 lines 1-5; col. 31 lines 27-56. Based on explicit or indirect user parameters specifications, the media server determines the content and advertisement for the user, col. 12 line 62 -col.

13 line 31; col. 18 lines 35-lines 62; col. 32 lines 32-54; col. 37 lines 43-63), and selecting a second image comprising a barker advertising the content of potential interest to the user (col. 9 lines 45-54; col. 18 lines 12-22; col. 34 lines 20-61; col. 18 lines 56-62), and wherein the processor determines the content of potential interest to the user based on the menu or programming guide selections made by the user (Based on explicit or indirect user parameters specifications, the media server determines the content and advertisement for the user, col. 12 line 62 -col. 13 line 31; col. 18 lines 35-lines 62; col. 32 lines 32-54; col. 37 lines 43-63)

a compressor for compressing at least one of the first image, the second image, and the third image prior to forming the targeted integrated image (**Encoding system 140, col. 25 line 60-col. 26 line 10**); and

a combiner for combining the second image with the first image or a third image to form a targeted integrated image for delivery to the user, and wherein the combiner inserts the second image within the first image or the third image, wherein the first image or the third image is adapted to appear to the user to be paused (**Enhanced media server 115, Fig. 1; col. 16 line 15- col. 17 line 5; col. 25 lines 34-58**).

Regarding claims 4, 27 and 28, Holtz teaches an apparatus (with respective method) wherein the user preference includes information representing content viewing habits or content ordering habits of the user (**Based on explicit or indirect user parameters specifications, the media server determines the content and**

advertisement for the user (col. 12 line 62 -col. 13 line 31; col. 18 lines 35-lines 62; col. 32 lines 32-54; col. 37 lines 43-63).

Regarding claims 5 and 29, Holtz teaches wherein the processor determines content of potential interest to the user based on an at least one user preference associated with an identity of the user **(Content is determined based on a direct request from the user or on a profile that's created based on information captured about user selections when the user logs on to the system, col. 13 lines 3-39; col. 17 lines 25-51; col. 18 lines 35-62. Therefore, it is inherent that the identity of the user is determined through the log in for selecting content that fits that specific user).**

Regarding claims 9-11, Holtz teaches the method wherein the first image includes at least a menu or a programming guide **(menu or listing 1104 to be displayed to the user, col. 8 line 24-col. 9 line 20; col. 17 lines 25-51 and, also that a specification menu is also sent to the user to customize the desired content, col. 16 lines 15-33; col. 17 lines 1-5; col. 31 lines 27-56. Based on explicit or indirect user parameters specifications, the media server determines the content and advertisement for the user, col. 12 line 62 -col. 13 line 31; col. 18 lines 35-lines 62; col. 32 lines 32-54; col. 37 lines 43-63).**

Regarding claims 13,16, 37, 38 and 40, Holtz teaches a method wherein the step of

determining is initiated responsive to the user requesting the video content (**col. 16 line 15- col. 17 line 5, col. 25 lines 34-58, abstract**).

Regarding claims 18-20 and 41-43, Holtz teaches an apparatus (with respective method) further comprising repeating the steps for creating at least one new targeted integrated image for delivery to the user; wherein the steps are repeated as the user continues to request or receive images or wherein the steps are recursively repeated for delivering new targeted integrated images for delivery to the user (**Holtz teaches creating integrated targeted content for a user based on a expressly user-defined parameters/profile or based on a profile that's created with information captured about user selections when the user logs on to the system. Given that the user changes, for at least that reason, the future content selected has to be new content on a system that is inherently not designed for being used for just one time. However, Holtz also explicitly teach that he steps of selecting targeted are repeated since every single time the user logs on the system, new targeted content is available for the user, which he/she has to select or reject. The user can also request specific content (col. 13 lines 3-39; col. 17 lines 25-51; col. 18 lines 35-62).**

Regarding claims 21, Holtz teaches an apparatus further comprising compressing at least one of the first image, the second image, and the third image prior to forming the targeted integrated image (**col. 25 lines 60-col. 26 line 16**).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **6- 8 and 30-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Holtz et al. (hereinafter 'Holtz', Patent No. 6,760,916) in view of Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047).

Regarding claims 6- 8 and 30-32, Holtz teaches all the limitations of the claims they depend on. On the other hand, Holtz does not teach selecting the second image from a queue and the steps of manipulating the images of the queue.

However, in an analogous art, Plotnick teaches selecting the second image from a queue (UAQ or [0011], [0014]). Plotnick also teaches the steps of determining content previously ordered or viewed by the user (In the same way as Holtz, Plotnick teaches keeping track of user's preferences and selections to get ads -[0083]- but, also controls what ads were played or viewed -[0061]-; determining images available in the queue, removing images related to the previously ordered or viewed content from the queue ([0151]). Moreover, Plotnick teaches marking the second image delivered to the user as having been delivered; and placing the marked image at the end of the queue, wherein the step of selecting selects images sequentially from the beginning of the queue

[(0061)].

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to have modified Holtz' invention with Plotnick's capability of queuing the targeted ads for the benefit of a fast insertion process.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is (571)270-1449. The examiner can normally be reached on 9-6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone

Art Unit: 2623

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OP
/Christopher Grant/
Supervisory Patent Examiner, Art Unit 2623